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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,320	12/29/2000	Raul S. San Martin	10360-077001 / 12299RO	9159

26161 7590 10/13/2004

FISH & RICHARDSON PC  
225 FRANKLIN ST  
BOSTON, MA 02110

EXAMINER
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FAROOQ, MOHAMMAD O

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/751,320	SAN MARTIN ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mohammad O. Farooq	2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 22-25 is/are rejected.
- 7) ☒ Claim(s) 20 and 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

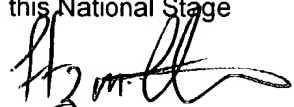
**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**FRITZ FLEMING**  
**PRIMARY EXAMINER**  
**GROUP 2100**

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 6 and 13 recites the limitation "backing up or back up" in depending from claim 1 and claim 9 respectively. However, there is no mention of "backing up or back up" either in claim 1 or in claim 9. Since claim 7 depends on claim 6, claim 7 also falls in this category. There is insufficient antecedent basis for this limitation in the claim.
2. Claim 14 recites the limitation "signaling" in depending from claim 9. However, there is no mention of "signaling or signal" in claim 9. This office action treats claim 14 being dependent upon claim 13 since there is mention of "signal" in the claim. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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1. Claims 1, 9, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Kirouac et al. U.S. Pat. No. 5,155,847.

2. As to claim 1, Kirouac et al. teach method implemented in a computer program application for updating software on a programmable device, the method comprising:

providing two way communication between a server (i.e. central computer) and the programmable device (i.e. remote computer; via communication links; col.1, lines 67-68);

configuring an updating process that executes on the server (col. 1, lines 60-66);

updating the programmable device in accordance with the updating process (col. 2, lines 1-12);

testing the operation of at least a portion of the updated software on the programmable device after upgrading and prior to restarting the programmable device (col. 2, lines 13-26).

There is no mention in Kirouac et al. of restarting the programmable device after upgrading. Therefore, it concludes upgrading and testing/verification is one sequential process without any interruption of restart.

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3. As to claim 9, Kirouac et al. teach system for updating software on a programmable device comprising:

a server (central computer; see fig. 1);

a programmable device (remote computer) able to be in a two way communication with the server (col. 1, lines 67-68);

the server comprising computer software comprising instructions to cause the server to configure an update process (col. 1, lines 56-68);

update software on the programmable device in accordance with the update process (col. 2, lines 1-12);

test the operation of at least a portion of the updated software on the programmable device (col. 2, lines 13-15).

4. As to claim 23, Kirouac et al. teach method the programmable device restarts running the updated software if the programmable device passes the testing (col. 2, lines 1-62; col. 3, line 60 – col. 4, line 61).

5. Claim 24 is system claim of method claim 23. Kirouac et al. teach method as set forth in claim 23. Therefore, Kirouac et al. also teach system as set forth in claim 24.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-4,8, 10, 11, 15-18, 22 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirouac et al. U.S. Pat. No. 5,155,847 in view of Jones, U.S. Pat. No. 6,526,574 B1.

7. As to claims 2 and 3, Kirouac et al. do not teach method backing up at least a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; and backing up occurs on the programmable device. Jones teaches backing up at least a portion of the pre-existing software on the programmable device; based upon the testing, restoring the backed portion of the software on the programmable device; and backing up occurs on the programmable device (abstract).

However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kirouac et al. and Jones because that would implement the update according to the end user (abstract).

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8. As to claim 4, Kirouac et al. teach method the backing up occurs at the server (col. 3, line 60 – col. 4, line 61).

9. As to claim 8, Kirouac et al. teach method send a signal to a user based upon the testing outcome (i.e. implement checksums to verify the correct transmission; col. 2, lines 49-62).

10. As to claim 15, Kirouac et al. teach computer program product, tangibly stored on a computer-readable medium, for updating software on a programmable device, comprising instructions operable to cause a programmable processor to:

configure an update process (col. 1, lines 54-68);

communicate with the programmable device over a two way communications medium (col. 1, lines 67-68);

backup at least a portion of the software on the programmable device;

update software on the programmable device in accordance with the update process (col. 1, lines 54-68; col. 2, lines 1-12);

test the operation of at least a portion of the updated software on the programmable device (col. 2, lines 13-15).



Kirouac et al. do not teach backup at least a portion of the software on the programmable device. Jones teaches backup at least a portion of the software on the programmable device (abstract). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Kirouac et al. and Jones because that would implement the update according to the end user (abstract).

11. As to claim 25, Kirouac et al. teach method the programmable device restarts running the updated software if the programmable device passes the testing (col. 2, lines 1-62; col. 3, line 60 – col. 4, line 61).

12. Claims 10 and 11 are system claims of method claims 2 and 4, Kirouac et al. and Jones in combination teach method as set forth in claims 2 and 4. Therefore, Kirouac et al. and Jones in combination also teach system as set forth in claims 10 and 11.

13. Claims 16-18 are product claims of method claims 2-4. Kirouac et al. and Jones in combination teach method as set forth in claims 2-4. Therefore, Kirouac et al. and Jones in combination also teach product as set forth in claims 16-18.

14. Claim 22 is product claim of method claim 8. Kirouac et al. and Jones in combination teach method as set forth in claim 8. Therefore, Kirouac et al. and Jones in combination also teach product as set forth in claim 22.

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15. Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kirouac et al. U.S. Pat. No. 5,155,847 in view of DeKoning et al. U.S. Pat. No. 6,480,955 B1.

16. As to claim 5, Kirouac et al. do not teach the communications is over the Internet. DeKoning et al. teach the communications is over the Internet (col. 8, lines 10-18). However, it would have been obvious to one of ordinary skill in the art at the time of invention to combine the teachings of Krouac et al. and DeKoning et al. because that would provide completion progress messages to be communicated until the configuration change request is completely processed (col. 2, lines 36-54).

17. Claims 12 is system claim of method claim 5. Kirouac et al. and DeKoning et al. in combination teach method as set forth in claim 5. Therefore, Kirouac et al. DeKoning et al. in combination teach system as set forth in claim 12.

18. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kirouac et al. U.S. Pat. No. 5,155,847 in view of Jones, U.S. Pat. No. 6,526,574 B1 further in view of DeKoning et al. U.S. Pat. No. 6,480,955 B1.

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19. As to claim 19, neither Kirouac et al. nor Jones teach the communications is over the Internet. DeKoning et al. teach the communications is over the Internet (col. 8, lines 10-18). However, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Krouac et al. and Jones with DeKoning et al. because that would provide completion progress messages to be communicated until the configuration change request is completely processed (col. 2, lines 36-54).

***Allowable Subject Matter***

20. Claims 6,7, 13 and 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

21. Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

22. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

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23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad O. Farooq whose telephone number is (703) 305-3888. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**P.S. Effective October 13, 2004 the examiner can be reached at 571-272-4144 and the examiner's supervisor can be reached at 571-272-4146.**

  
FRITZ FLEMING  
PRIMARY EXAMINER  
GROUP 2100

Mohammad O. Farooq  
October 6, 2004